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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of Jerry Ham

Serial No. 10/738,417,

Filed Dec. 17, 2003

Title: **Inert Tactical Weapon System and Method of Use**

BOARD OF PATENT  
APPEALS & INTERFERENCES

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**AMENDED APPEAL BRIEF**

**I. REAL PARTY IN INTEREST.** The real party in interest in this appeal and application is Jerry Ham who is the sole inventor and sole owner of the rights to the invention. There has been no assignment of any rights.

**II. RELATED APPEALS OR INTERFERENCES.** There are NO related appeals or interferences connected in any way with this case.

**III. STATUS OF CLAIMS**

Claims 1 – 20 were filed with the case. As a result of a restriction requirement and response with traverse, claims 1 – 9 stand withdrawn from consideration

and claim 20 was cancelled

The claims under appeal are claims 10 through 19 which are submitted herewith, again, in Appendix VIII, which was filed with the original brief. An added copy, showing the last amendments to the claims, is also filed with Appendix VIII.

**IV. AMENDMENTS.** There are no amendments to the claims pending and they have been amended only once since the filing of the application. To restate, there are no pending amendments to the claims currently in the application.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claims can be summarized as follows:

The claims call for a CO2 neutralizing system for use against terrorists and the like where the terrorists have hostages in a confined space and therefore the use of guns and conventional weapons is precluded due to the presence of the hostages.

Claim 10, the independent claim upon which all the remaining claims are based, calls for a source of CO2, a means to create an opening into the confined space and a means to deliver the CO2 into the space, the means to create an opening and the means to deliver CO2 being operatively connected. The means plus function are a combination

of the lance 20 and the battering ram 21 shown in Figures 1 –3 and mentioned in the last paragraph of Page 8.

Claim 11, dependant upon claim 10, defines the CO2 source as a tank 11 with a delivery hose 13 shown in Figure 1. . . Claim 17, dependant on claim 11, which recites that the two means are one in the same member. I.e. the lance and battering ram constitute the means to create an opening and deliver gas are the lance 17 and battering ram 21.. . Claim 18, dependant upon claim 17, recites that one portion of it is a lance, 17 shown in Figure 1, and the other a battering ram 21, mentioned on page 8 of the specification.. . Claim 19, dependant upon claim 18, adds the limitation that the member has an adjustment valve 12 ( page 8, last paragraph ) for regulating the gas.

Claim 12 , dependant upon claim 10, defines the means to create an opening as a battering ram 21 shown in figures 2 and 3 and mentioned on pages 8, last paragraph and on page 9, first paragraph.

Claim 13 , dependant on claim 10, calls for the delivery means to comprise a hollow lance 17 and connected to the battering ram 21 at the forward end thereof. . Claim 14, dependant on claim 13, adds the limitation of the lance having a valve means, 12 as seen in Figure1- 4. to control the gas. . Claim 15, dependant on claim 14, adds the limitation of the lance having dissipation holes 35 to disperse the gas into the confined space.

Claim 16, dependant on claim 10, adds the limitation that the gas has an odorant mixed therein so as to create a false impression of the nature of the gas. . Claim 17 recites the combination of the lance and battering ram 21.

Claim 19 calls for an adjustment valve, 12, as shown in Figure 1.

**VI. REJECTIONS** The claims have been rejected as anticipated by McClenahan and Coughlin and as obvious over Roberts in view of either Medlock or Coughlin. This is an interesting scenario the Examiner has formulated which, as will be pointed out, is replete with contradictions.

(i) Claims 10 – 15 and 17 – 19 are rejected under 35 USC 103 as unpatentable over Roberts ( '753 ) in view of either Medlock ( 005 ) or Coughlin ( 417 ).

Roberts discloses a fire fighting device which is used to punch a hole in a wall to inject a fog or mist for dousing the fire. It employs a nozzle 10 having orifices such as 38 which allow the chemical to flow through the wall via the nozzle and disperse into the room space. A ram 12 is used to drive the nozzle through the wall. The invention appears to be, with reference to the claims, the angles and arrangement of the orifices in the nozzle.

Medlock shows a device for fighting fires in aircraft fuselages while the aircraft is on the ground. The device employs a nozzle 36 which, at the end of a long truck mounted boom, penetrates the skin of the fuselage when the truck runs the boom ( and nozzle ) into the side of the aircraft. There is no ram, per se. The device uses CO2 to flow down the boom and into the aircraft fuselage through the nozzle.

Coughlin discloses a base for a fire fighting device on a ship where a ram is used to

drive a nozzle through the steel of a bulkhead on the ship. The nozzle can have orifices through which CO2 or another firefighting agent can be dispersed into the ship.

**(ii) Claim 10 – 19 are also rejected as being anticipated by McClenahan under 35 USC 102(b).**

McClanahan discloses a barrier penetrator for firefighters. The device has a slide hammer to penetrate a wall with a nozzle having ports 51 through which a fire fighting agent flows into the confined space penetrated by the slide nozzle. The invention appears to be a very detailed and limited configuration as evidenced by claim 1 thereof. McClanahan shows a penetrator having an impact barrel with a central axis, an internal guide wall, an axially extending nozzle in said impact barrel, having an axially extending passage, with nozzle ports, a point and shoulder on said nozzle, a slide rod in an end cap and a collar on said rod, a slide hammer slideable mounted on said rod, retention means, and an inlet port means. The Examiner states that in lines 12 through 22 of column 1 there is mention of an odorant.

Claim 16 calls for an odorant to disguise the smell of the CO2 and the Examiner states that such odorant is shown in McClanahan.

**(iii). Claims 10 – 15 and 17- 19 are also rejected as anticipated by Coughlin under 35 USC 102 (b).**

Coughlin discloses a “base for a fire-fighting tool”. While there are several embodiments shown, the basic invention is a deck mounted member ( see Claim 1 )

which connects with a support leg of a firefighting tool which is ram operated and entails a nozzle 19 having an angled surface adapted to penetrate a bulkhead or the like on a ship. An extendible ram 23 has air injected therein to force the nozzle through a bulkhead. Once the bulkhead is penetrated liquid to fight fire is forced into the space through orifices 51. The invention is basically designed to work on steel walls as one would find in a ship. While the use of CO2 is mentioned in line 4 of column 2 it is in reference to a prior patent, U. S. No. 2,732, 017, which is used to extinguish burning tires and in column 23, line 8 where it is mentioned as a means to fight a fire.

## **VII. ARGUMENTS ATTACKING REJECTIONS**

### **Rejection of claims 10 – 15 and 17 – 19 under 35 USC 103 over Roberts in view of either Coughlin or Medlock.**

(i) The rejection of claims 10 – 15 and 17 – 19 as unpatentable over Roberts in view of either Coughlin or Medlock is ill taken and does not stand up to scrutiny. The initial problem is with the basic reference Roberts, which is not an anti-terror device but merely a mechanism for suppressing fire. There is simply no teaching of using the device for dealing with terrorists who have captives. Nor would there be any reason for modifying Roberts to use CO2. For what reason? Where is the problem that Roberts is solving that would be solved by using CO2. The Examiner merely suggests that it would be obvious to substitute one fire suppressant for another and relies on either secondary reference to do so. What he does not state is that there is no teaching of a

reason to do this. What hostage situation is the Examiner responding to by applying Roberts who says nothing about terrorists and hostages. There simply is no teaching reference. Why would you change suppressants in Roberts? Roberts states, line 4 of column 1 that he is using a spray, mist or fog. None of that sounds like CO2 so there is no reason to make the substitution. Neither do Coughlin or Medlock describe neutralizing terrorist in a hostage situation. The Examiner makes the substitution for another reason having nothing to do with this invention. Just because CO2 is described as a fire suppressant is not sufficient to make the mental jump to substituting it or even using it for a terrorist neutralization.

The standard imposed by 35 USC 103 is that the differences between the subject matter sought to be patented and the prior art are such that “the subject matter as a whole would have been obvious ....to a person having ordinary skill in the art to which the subject matter pertains.” (emphasis added). In the instant case, the subject matter to which this invention applies is the submission of terrorists in a hostage situation, not how to put out a fire in a building. Here, the subject matter is totally different from the applied prior art. Roberts has no teaching of using a penetrator-ram to gain access to a confined space in which terrorists are holding hostages. He is merely concerned with putting out a fire.

A reference must be considered in its entirety and Roberts is not directed to a device or system for neutralizing terrorists. The Examiner cannot pick and chose those parts of a reference which fits his argument See In re Fracalossi, 681 F2d 792, 794 215, USPQ 569 (CCPA 1982) The Board of Patent Appeals and Interferences has

cautioned against focusing on the obviousness of the differences between the prior art and the claimed subject matter rather than on the obviousness of the invention as a whole as §103 requires. See Hybritech Inc. v. Monoclonal Antibodies, Inc. 802 F2d 1367, 1383, 231 USPQ 81, 93 ( Fed. Cir. 1986 ) There must be a basis in the art for combining or modifying references. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, *absent some teaching, suggestions, or incentive supporting the combination.* ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) The Examiner merely suggests that it would be obvious to substitute one fire suppressant for another and relies on either of the secondary references to do so. What the Examiner does not state, however, is that there is no teaching of a reason to do this.

#### **Claims 10 – 19 rejection under 35 USC 10 over McClenahan**

(ii) The rejection of claims 10 – 19 as anticipated by McClenahan is unsustainable. Right off the bat the Examiner states that the odorant is shown by McClenahan. Not so! For what purpose would an odorant be used in a fire suppressant system? In the instant invention the odorant is to mask the smell of the CO2 so as not to “tip off” the terrorists as to the true nature of what gas is being introduced. There is not mention of an odorant in lines 12 through 22 of column 1 as stated by the Examiner. The only function of the slide in McClenahan is to penetrate the thin aluminum outer skin of the fuselage and not much weight is required. It is not akin to penetrating a door or wall in a hostage situation. In addition, in a hostage situation one cannot just “pour” into huge quantities

of CO2 as it must be carefully monitored based on the size of the space. The amount is designed to make the occupants of the space groggy and not cognizant of their situation but not to kill them which uncontrolled amounts of gas would do. Once the occupants are groggy a hostage rescue team can evacuate the hostages and other law enforcement can secure the terrorists. The first priority are the hostages, not the terrorists.

The proscription of 35 USC 102 (b) is that the subject matter is not patentable if the invention was “patented or described in a printed publication” more than one year before the application under consideration. Here, the invention was not patented or described in a printed publication. The McClenahan reference is not an invention for dealing with terrorists by introducing CO2 into a space where they are holding hostages. It deals only with putting out fires. One cannot modify McClenahan without some basis in the art for combining or so modifying his teaching. Nor is there any mention in that prior art of an “odorant” as in claim 16. Likewise, the adjustment valve recited in claims 14 and 19 is to regulate the amount of CO2 so as not to kill the occupants of a building. Nowhere in McClenahan is it disclosed that such a valve is used to adjust the amount of CO2 in particular.

A claim defines the metes and bounds of the rights which applicants seek to cover. Claim 10 calls for “A CO2 neutralizing system for use against terrorists and/or hostage takers within a confined space.” The Examiner is not interpreting the correct metes and bounds which applicant requests in the claims. In re Vamco Machine & Tool Co., Inc, 752 F2d 1564, 1577 , 224 USPQ 617, 625, ( Fed. Cir. 1985 )

### **Rejection of Claims 10 – 15 and 17 – 19 under 35 USC 102 over Coughlin**

(iii) Nowhere in the Coughlin patent, which is used to reject claims 10 – 15 and 17 – 19 as anticipated by its disclosure, does he mention the use of a device to combat terrorism. Obviously, in such a situation one would not want to have a fire in the space and the use of CO<sub>2</sub> has to be very carefully monitored unlike in a situation only involving a fire. There is no need in the latter case to monitor the amount or density of the gas. In essence the problems that the instant invention seeks to redress are totally different from that of the reference.

Again, the reference does not show that the “invention was patented or described in a printed publication” more than one year before this application was filed. The invention here is a system for dealing with terrorists, not a fire treatment system. For a rejection to be sustained under 35 USC 102(b) the prior art must *identically disclose* the claimed invention. Nor does Coughlin concern himself with regulating the amount of CO<sub>2</sub> so as not to kill the occupants of the building. Nor does he mention anywhere the use of an odorant to disguise the CO<sub>2</sub> to occupant terrorists who might kill the hostages or commit some other act if they realized they were being subjected to CO<sub>2</sub>. Coughlin merely is concerned with fighting fires, nothing else. This rejection is really a 103 rejection without a base teaching reference....it is not a 102(b) rejection

Nowhere in the Coughlin patent does he mention the use of a device to combat terrorism where the terrorists have hostages.

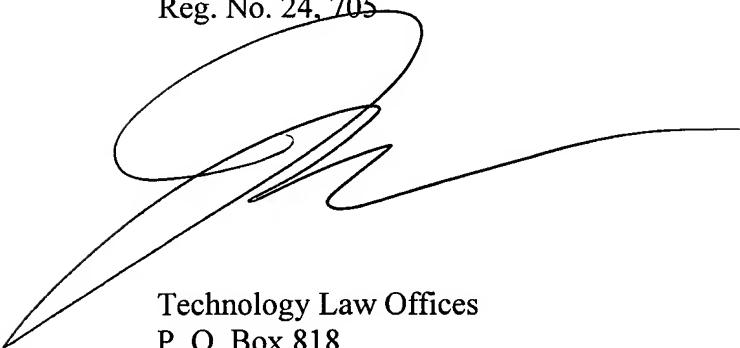
## **VII. Conclusion**

For all the foregoing reasons it is believed that the three rejections of the claims, two based on 35 USC 102(b) and one on 35 USC 103 should be reversed and allowance of claims 10 though 19 is respectfully requested.

## **VIII. The claims on appeal, 10 – 19, are attached as appendix VIII.**

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "JAMES W. HINEY".

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APPENDIX VIII , CLAIMS OF Serial No. 10/738,417 ( revised format )



CLAIMS ON APPEAL

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10. A CO<sub>2</sub> neutralizing system for use against terrorists and/or hostage takers within a confined space, said system comprising

a source of CO<sub>2</sub>,  
manual non-explosive means to create an opening in said space,  
and means to deliver said CO<sub>2</sub> from said source into said space.  
said means to deliver said CO<sub>2</sub> operatively connected to said means to create an opening.
11. A system as in claim 10 wherein said gas source is a tank with a delivery hose.
12. A system as in claim 10 wherein said means to create an opening in said space comprises a battering ram for punching a hole in a wall or door.
13. A system as in claim 10 wherein said means to deliver said gas from said source to said space comprises a hollow lance, said lance being connected to said battering ram at the forward end thereof.
14. A system as in claim 13 wherein said lance means has a valve thereon

whereby the flow of gas can be controlled.

15. A system as in claim 14 wherein said lance has dissipation holes therein whereby the gas may disperse into the confined space.
16. A system as in claim 10 wherein said CO<sub>2</sub> has an odorant mixed therewith to create a false impression of the nature of the gas.
17. A system as in claim 11 wherein the means for creating an opening in said space and the means to deliver said gas are the same member.
18. A system as in claim 17 wherein said member comprises a hollow lance for introducing gas into said space and the opening for said lance is created by a portion of said member being a battering ram.
19. A system as in claim 18 wherein said member has an adjustment valve thereon for regulating the amount of gas that flows into said space.

Appendix VIII

10. (Currently amended ) A [ inert gas] CO2 neutralizing system for [use against] use against terrorists and/or hostage takers within a confined space, said system comprising

a source of [inert gas,] CO2,  
manual non-explosive means to create an opening in said space, and means to deliver said [inert gas] CO2 from said source into said space. said means to deliver said CO2 operatively connected to said means to create an opening.
11. ( Original ) A system as in claim 10 wherein said gas source is a tank with a delivery hose.
12. ( Original ) A system as in claim 10 wherein said means to create an opening in said space comprises a battering ram for punching a hole in a wall or door.
13. ( Currently amended ) A system as in claim 10 wherein said means to deliver said gas from said source to said space comprises a hollow lance, said lance being connected to said battering ram[.] at the forward end thereof.

14. ( Original ) A system as in claim 13 wherein said lance means has a valve thereon whereby the flow of gas can be controlled.
15. ( Original ) A system as in claim 14 wherein said lance has dissipation holes therein whereby the gas may disperse into the confined space.
16. ( Currently amended ) A system as in claim 10 wherein said [inert gas is CO2.]  
CO2 has an odorant mixed therewith to create a false impression of the nature of the gas.
17. ( Original ) A system as in claim 11 wherein the means for creating an opening in said space and the means to deliver said gas are the same member.
18. ( Original ) A system as in claim 17 wherein said member comprises a hollow lance for introducing gas into said space and the opening for said lance is created by a portion of said member being a battering ram.
19. ( Currently amended ) A system as in claim 18 wherein said member has an adjustment valve thereon for regulating the amount of gas that flows into said space.
20. ( Cancelled ) A system as in claim 10 wherein said system is mounted inside a commercial aircraft and said means to create an opening into the space, which is a

passenger compartment, is a remote valve controlled from the aircraft cockpit.